

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. Claims 1-3 and 5-9 are canceled without prejudice to submitting claims of the same or similar scope in a related proceeding, e.g., continuation application. After entrance of the present amendment, claims 4, 10-16, 34-42, and 57 are pending.

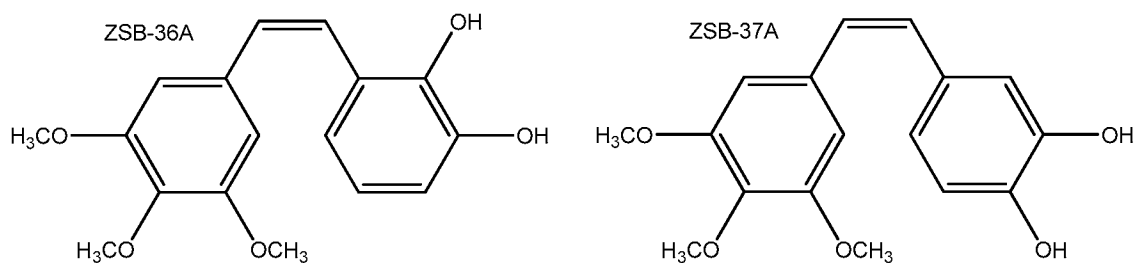
Applicant acknowledges the Examiner's determination that elected species, ZSB-71, is free of the prior art. The search now is extended to all stilbene compounds with ortho-catechol moieties. Claims 5-9 are withdrawn from consideration allegedly for being drawn to a nonelected species, and are canceled as noted above.

35 U.S.C. § 112, first paragraph (enablement)

Claims 1-3 stand rejected under 35 U.S.C. § 112, as failing to comply with the enablement requirement. C In order to advance prosecution of the present application, claims 1-3 are canceled, without prejudice, thereby rendering the rejection moot.

35 U.S.C. § 102 - anticipation

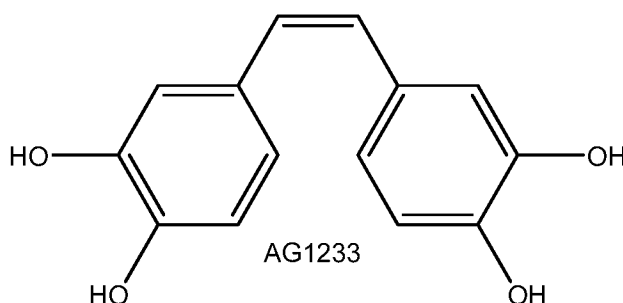
Claims 1-4, 10-16, 34-42 and 57 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US 6,919,324. In particular, the Office calls attention to ZSB-36A and ZSB-37A at columns 27 and 28.



35 U.S.C. §102(e) provides that “A person shall be entitled to a patent unless ...the invention was described in ... a patent granted on an application for patent filed in the United States ***before the invention by the applicant*** for patent...” The enclosed

Declaration under 37 C.F.R. § 1.131 by Kevin G. Pinney, a co-inventor of the present application and of U.S. Patent No. 6,919,324, provides evidence that both ZSB-36A and ZSB-37a (plus their corresponding phosphate prodrugs) were conceived of and reduced to practice by the inventors of the present application prior to the 24 October 2002 filing date of U.S. Patent No. 6,919,324. Therefore, the cited patent is not available as prior art under 35 U.S.C. § 102(e). Applicant requests withdrawal of the present rejection.

Claims 4, 10-16, 34-42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blum, et al., *Biochemistry* 39:15705-15712 (2000). Claims 4, 10 and 34 are amended to bring the scope of the claims more closely in alignment with the working examples provided in the specification. Compound AG1233 falls outside the scope of claims 4, 10-16 and 34-42, as amended. Accordingly, Blum, et al. does not anticipate the presently claimed invention. Application respectfully requests withdrawal of the present rejection.

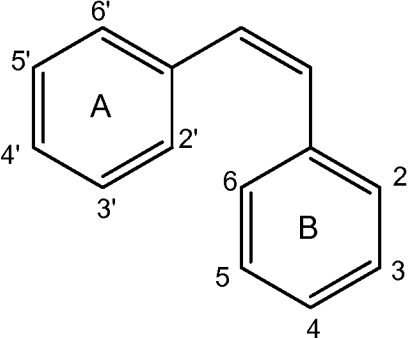


Double Patenting

Claims 1-4, 10-16, 34-42 and 57 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,919,324. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985). Notably, the entire

disclosure of the reference patent is not at issue -- merely, the claims. Applicant submits that the subject matter of claims 1-5 of U.S. Patent No. 6,919,324 does not render the claims of the present invention obvious.

The following table demonstrates that while there is some limited overlap between the presently pending claims and those of U.S. Patent No. 6,919,324, the scope of these claims are significantly different. Most notably the substitutions on the A-ring of the stilbene are extremely limited in the '324 Patent. One of skill in the art would not be motivated to substitute the A-ring with anything other than methoxy, and perhaps closely related small alkoxy moieties, such as ethoxy or propoxy. Further there is no motivation to substitute either of the 2'- or 6'- positions. Similarly, the substitutions on the B-ring vary even more broadly, with the present claims (1) not permitting substitutions such as amine or nitro, (2) allowing substitutions with alkyl, allyl, allyloxy and the like, and (3), most importantly, requiring that the B-ring include *ortho*-quinone moiety, *ortho*-catechol or *ortho*-catechol prodrug moiety. Nothing in the claims of the 6,919,324 patent would lead one of skill in the art to contemplate such a requirement.

		
	6,919,324	claim 4
2'	H	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, or trihaloalkyl
3'	-OCH ₃	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, or trihaloalkyl
4'	-OCH ₃	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower

		alkanoyloxy, halogen, or trihaloalkyl
5'	-OCH ₃	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, or trihaloalkyl
6'	H	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, or trihaloalkyl
2	H, OH, lower alkoxy, NH ₂ , NO ₂ , N ₃ , NH-R ₆ , halogen, -OP(O)(O ⁻ M ⁺) ₂ , -OP(O)(OR ₉)(O ⁻ M ⁺), or -OPO ₃ R ₇ R ₈	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, trihaloalkyl, lower alkyl, allyl, allyloxy, vinyl, vinyloxy, OH, C ₁₋₅ alcohol
3	H, OH, lower alkoxy, NH ₂ , NO ₂ , NH-R ₆ , -OP(O)(O ⁻ M ⁺) ₂ , -OP(O)(OR ₉)(O ⁻ M ⁺), or -OPO ₃ R ₇ R ₈	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, trihaloalkyl, lower alkyl, allyl, allyloxy, vinyl, vinyloxy, OH, C ₁₋₅ alcohol
4	H, lower alkoxy, -OP(O)(O ⁻ M ⁺) ₂ , -OP(O)(OR ₉)(O ⁻ M ⁺), or -OPO ₃ R ₇ R ₈	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, trihaloalkyl, lower alkyl, allyl, allyloxy, vinyl, vinyloxy, OH, C ₁₋₅ alcohol
5	H, OH, lower alkoxy, NH ₂ , NO ₂ , N ₃ , NH-R ₆ , halogen, -OP(O)(O ⁻ M ⁺) ₂ , -OP(O)(OR ₉)(O ⁻ M ⁺), or -OPO ₃ R ₇ R ₈	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, trihaloalkyl, lower alkyl, allyl, allyloxy, vinyl, vinyloxy, OH, C ₁₋₅ alcohol
6	H, OH, lower alkoxy, NH ₂ , NO ₂ , N ₃ , NH-R ₆ , halogen, -OP(O)(O ⁻ M ⁺) ₂ , -OP(O)(OR ₉)(O ⁻ M ⁺), or -OPO ₃ R ₇ R ₈	H, lower alkoxy, cycloalkoxy, heterocycloalkoxy, aryloxy, lower alkanoyloxy, halogen, trihaloalkyl, lower alkyl, allyl, allyloxy, vinyl, vinyloxy, OH, C ₁₋₅ alcohol

Applicant requests withdrawal of the non-statutory double patenting rejection of claims 4, 10-16, 34-42 and 57.

Applicant believes that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-4279. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-4279. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-4279.

Respectfully submitted,

By:

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